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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/728,056	12/04/2000	Pascal Arnaud	200436US0	3932
22850	7590	01/27/2005	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				WANG, SHENGJUN
ART UNIT		PAPER NUMBER		
1617				

DATE MAILED: 01/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/728,056	ARNAUD, PASCAL
	Examiner Shengjun Wang	Art Unit 1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 24 September 2004.

2a) This action is **FINAL**.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-44 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-44 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

## **DETAILED ACTION**

Receipt of applicants' amendments and remarks submitted September 24, 2004 is acknowledged.

### ***Claim Rejections 35 U.S.C. 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walling et al (US Pat. 5,948,394) in view of Jakobson et al (US Pat. 5,093,043).

Walling teaches transfer-resistant lip compositions. The compositions resist transfer upon subjecting the wearer to routine or daily activities. The compositions are in the form of Lipstick (see abstract). The compositions comprise lipophilic materials and a variety of other components (see claims 1-6). Walling teaches that a preferred volatile hydrocarbon fluid for use in the invention is isododecane (see col. 4, lines 1-16, and col. 6, line 15 through col. 7, Line 45\*, examples 1-6). Walling further teaches that a particularly useful silicone fluid for use in the invention is available as the 556 series from Dow Corning (see col. 5, lines 3-9). DC 556 is a trade name for phenyltrimphicone. Walling further teaches that phenyltrimethicone is a most preferred fluid for the invention (see col. 5, Lines 17-20). Walling teaches that various surfactants may be employed in the composition. Examples 1-6 are further comprised of wax and pigments. Additionally, examples 1-4 and 6 contain polyglycerol diisostearate.

Willing does not teach expressly the particular percentages of each ingredients, or expressly states the employment of diglyceryl diisostearate.

However, Jakobson teaches a process for preparing nonionic surfactants. The reference relates to the use of certain nonionic polyglycerol fatty acid ester surfactants as additives or solvents for skin protection agents and skin care oils and for cosmetic formulations (see col. 3, line 47 through col. 4, line 11). Jakobson teaches that diglycerol difatty acid esters have improved properties as compared to polyglycerol esters (see col. 4, lines 54-64). Jakobson specifically compares diglycerol diisostearate with commercial polyglycerol diisostearate (see col. 5, lines 17-20). Jakobson further disclosed that commercial polyglycerol diisostearate is essentially diglycerol diisostearate. See column 5, lines 24-28.

Therefore, it would have been *prima facie* obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to make a lip cosmetic composition comprising isododecane, phenyltrimphthicone, and diglycerol diisostearate (such as those disclosed by Jakobson) in a percentage as herein cited.

A person of ordinary skill in the art would have been motivated to make a lip cosmetic composition comprising isododecane, phenyltrimphthicone, and diglycerol diisostearate (such as those disclosed by Jakobson) in a percentage as herein cited because all of the ingredients are known to be useful in lip composition. As to the particular percentage, note where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. *In re Aller*, 220 F.2d 454, 105 USPQ 233, 235 (CCPA 1955). Further, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the compositions of Walling by the substitution of

diglycerol diisostearate for polyglycerol diisostearate as taught by Jakobson in order to benefit from the improved properties of diglycerol diisostearate as taught by Jakobson.

***Response to the Arguments***

Applicants' amendments and remarks submitted September 24, 2004 have been fully considered, but are not persuasive.

Applicants argue that "Walling generally discloses combining several different type of oil and waxes to form lipstick products." And "this teaching is so general that it provide no guidance whatsoever concerning which oils and wax could be advantageously combined."

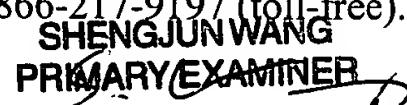
Applicant further cites *In re Meyer* and *Akzo v. International Trade Comm'n* in support the arguments. The examiner respectfully disagrees. There is no law stateing a species can not be obvious over a geneus. In fact, In the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a *prima facie* case of obviousness exists. *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990). Wherein there is a range disclosed in the prior art, and the claimed invention falls within the range, there is a presumption of obviousness. The presumption will be rebutted if it can be shown: 91) That the prior art taught away from the claimed invention, *In re Geisler*, 116 F.3d 1465, 1471 (Fed. Cir, 1997); or that there are new and unexpected results relative to the prior art, *In re Woodruff*, 919 F.2d 1575, 1578 (Fed. Cir. 1990). In both *In re Meyer* and *Akzo v. International Trade Comm'n*, there were objective evidences of non-obviousness sufficient to rebut the obviousness assumption. In the instant case, applicants' discovery is that for two incompatible non-volatile oil, a volatile oil has to be used. The prior art particularly teach the use of volatile oils, including the preferred volatile oil herein, with the nonvolatile oils.

Therefore, whether two non-volatile oils are incompatible without the presence of the volatile oil is not relevant to the issue in the rejection since the prior art teach the employment of volatile oils. See, particularly, col. 4, line 10-15 and the examples in Walling et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang whose telephone number is (571) 272-0632. The examiner can normally be reached on Monday to Friday from 7:00 am to 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
SHENGJUN WANG  
PRIMARY EXAMINER

Shengjun Wang  
Primary Examiner  
Art Unit 1617